

REMARKS

Claims 1-20, 23-31, 34, 35, 37-98, 101-113, 116-122, and 124-129 are pending in this application. By this amendment, claims 21, 22, 32, 33, 36, 99, 100, 114, 115 and 123 are canceled without prejudice or disclaimer. Claim 19 is amended to correct its dependency. Claims 30, 97, 112, 122 and 129 are amended to replace terms that are not supported by the parent application with terms that are supported by the parent application. Claims 113, 116, 119, 121, 123-128 are amended to correct typographic errors. No new matter is introduced. Reconsideration and prompt allowance of the claims are respectfully requested.

Priority

This application is a continuation of application serial number 08/912,934, filed August 15, 1997 (now U.S. Patent NO. 6,539,548), which is a continuation of application serial number 08/160,282 filed December 2, 1993 (now U.S. Patent No. 5,659,350). The Office Action alleges that the instant application adds and claims additional disclosure not presented in the prior application. Applicants respectfully submit that all the pending claims are supported by the parent application No. 08/160,282, and the applications incorporated by references, all of which were also filed on December 2, 1993 (page 1, line 15-25). Accordingly, Applicants respectfully submit that the present application complies with 35 USC 120 and 37 CFR 1.78 and that the priority claim of December 2, 1993 is proper. Reconsideration of the priority of all pending claims is respectfully requested.

Double Patenting Rejection

Claims 1, 34, 38, 62, 87, 108, 119, and 127 are rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,539,548 for reasons stated on pages 4-6 of the Office Action. Applicants have enclosed a terminal disclaimer in compliance with 37 CFR 1.132 (c) to overcome the rejection. Accordingly, the grounds for the double patenting rejection have been obviated. Withdrawal of the double patenting rejection is respectfully requested.

35 U.S.C. § 112 Rejections

Claims 19, 21, 22, 30-33, 36, 37, 91, 92, 97-100, 112-115, 122, 123, 126, and 129 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner, however, did not provide the specific ground for rejection of each claim, except claims 21, 22, 36 and 123. Applicants respectfully traverse the rejection. In doing so, Applicants will make a number of assumptions arguendo solely for the sake of discussion and without admitting that any such assumption is warranted.

With respect to claim 19, Applicants assume that the claim is rejected either for the lack of antecedent basis for “advertisements,” or for the lack of support for the limitation “wherein the advertisements are displayed prior to display of the chosen program.”

With regard to the antecedent basis, claim 19 has been amended to depend on claim 16, which provides the antecedent basis for “advertisements.”

With regard to the support for the limitation, Applicants respectfully submit that the limitation “wherein the advertisements are displayed prior to display of the chosen program” is supported by US Patent No. 5,734,853 (the ‘853 patent), which was incorporated by reference (page 1, lines 20-21). The ‘853 patent provides, in pertinent part, that:

Immediately after the subscriber turns on the set top terminal 220, the Introductory menu welcomes the subscriber to the system. The Introductory menu may display important announcements from the local cable franchise, advertisements from the cable provider, or other types of messages. In addition, the Introductory menu can inform the subscriber if the cable headend 208 has sent a personal message to the subscriber's particular set top terminal 220.

After the Introductory menu has been displayed the subscriber may advance to the next level of menus, namely the Home menu. In the preferred embodiment, after a certain period of time, the cable system will advance the subscriber by default to the Home menu. From the Home menu, the subscriber is able to access all of the programming options. The subscriber may either select a program directly by entering the appropriate channel number from the remote control 900, or the subscriber may sequence through incremental levels of menu options starting from the Home menu. The Home menu lists categories that correspond to the first level of menus called Major menus.

It is clear from this description that the advertisements may be displayed immediately after the Introductory menu and “prior to display of the chosen program.”

With respect to claims 30, 97, 112, 122, and 129, Applicants assume that the claims are rejected because the Examiner could not find support for the imitation “first-run movie.” Claims 30, 97, 112, 122, and 129 have been amended to replace the term “first-run movie” with the term “hit movie.” The latter term is supported by Figures 18 and 20 of the parent application (US Patent Application No. 08/160,282, now US Patent No. 5,659,350).

With respect to claims 31, 98, 113, and 126, Applicants assume that the claims are rejected because the Examiner could not find support for the imitation “sporting event subscription.” Applicants respectfully submit that “sporting event subscription” is supported by the parent application and the incorporated references. For example, Figures 18 and 20 of US Patent 5,659,350 (the ‘350 patent) illustrate sporting event in a specialty program. The ‘350 patent provides, in pertinent part, that:

...a sporting program may be assigned a code of B35-010194-1600-3.25-Michigan St. vs. USC. The letter B assigns the program to category B, sports. The second alpha-numeric character number 3 assigns the program to the third menu of the sports category. The third character of the code, number 5, assigns the program to the fifth program slot on the third menu.” (col. 20, lines 19-25).

With respect to claim 37, Applicants assume that the claim is rejected because the Examiner could not find support for the imitation “managing the yield of the programs watched information for the targeted program so that the targeted program yields higher programs watched information.” Applicants respectfully submit that the limitation is supported by the parent application and the incorporated references. For example, the ‘350 patent provides, in pertinent part, that:

The Marketing Information Interface (MII) 402 subroutine interfaces the processing and editing subroutines with marketing data. This interface regularly receives programs watched information from billing sites 420, cable headends 208, or set top terminals 220. In addition, other marketing information 422 such as the demographics of subscribers during certain time periods may be received by the MII 402. The MII 402 also uses algorithms 424 to analyze the program watched information and marketing data 420, 422, and provides the analyzed information to the processing and editing subroutines. In an embodiment,

the Executive Information System (EIS) with a yield management subsystem is included in the MII subroutine" (col. 22, lines 24-37).

With respect to claims 91 and 92, Applicants assume that the claims are rejected because the Examiner could not find support for the imitation "wireless modem" or "cable modem." Applicants respectfully submit that the limitations are supported by the parent application and the incorporated references. For example, US Pat. No. 5, 734,853, which is incorporated by reference (page 1, lines 20-21), provides:

FIG. 5a shows a basic block diagram of the hardware components of a digital compression set top terminal 220. The set top terminal 220 has a decryptor 600, tuner 603, digital demodulator 606, and demultiplexers 609, 616 as well as audio equipment 612, 614. Also shown in FIG. 5a is a remote control interface 626 for receiving and processing signals from a remote control unit 900. A modem 627 is provided for allowing communication between a microprocessor 602 and the cable headend 208 (but not shown in FIG. 5a). An NTSC encoder 625 provides an NTSC video output.

The microprocessor 602 is capable of executing program instructions stored in memory. These instructions allow a user to access various menus by making selections on the remote control 900. The various program instructions for accessing menus and performing other functions are described below.

Applicants respectfully submit that one skilled in the art would understand at the time of the invention that modem 627 could be a wireless modem or cable modem. Accordingly, claims 91 and 92 are properly supported by the specification.

With respect to claims 21, 22, 36, 114, and 123, the Examiner insisted that there is no evidence that the later used term "internet service provider" was directly conveyed in the parent application disclosure. Applicants respectfully submit that one skilled in the art would consider Prodigy or AOL as an "internet service provider" in December, 1993, when the parent application was filed. Applicants, however, have canceled these claims without prejudice or disclaimer. The rejection of these claims is now moot.

With respect to claims 32, 33, 99, 100, and 115, Applicants assume that the claims are rejected for the lack of antecedence for "full/partial season subscription" or "favorite team subscription." Claims 32, 33, 99, 100, and 115 have been canceled without prejudice or disclaimer. The rejection of these claims is now moot.

35 U.S.C. § 103 Rejections

Claims 19, 21, 22, 30-33, 36, 37, 91, 92, 97-100, 112-115, 122, 123, and 126 are rejected under 35 U.S.C. §103 (a) as being unpatentable for reasons stated on pages 7-12 of the Office Action. Applicants respectfully traverse the rejection.

The Office Action alleges that the parent application fails to support the limitations addressed in these claims and that the effective date of the claims is November 3, 1998. Applicants respectfully submit that the claims, as amended, are all supported by the parent application and the applications incorporated by reference. Accordingly, the present application complies with 35 USC 120 and 37 CFR 1.78 and the priority claim of December 2, 1993 is proper for all pending claims.

Claims 19, 30, and 31 are allowable because they depend on allowable claim 1 and for the additional features they recite.

Claim 37 is allowable because it depends on allowable claim 34 and for the additional features it recites.

Claims 91, 92, 97 and 98 are allowable because they depend on allowable claim 87 and for the additional features they recite.

Claims 112 and 113 are allowable because they depend on allowable claim 108 and for the additional features they recite.

Claim 122 and 126 are allowable because they depend on allowable claim 119 and for the additional features they recite.

Applicants therefore respectfully request withdrawal of the rejection of claims 19, 30, 31, 37, 91, 92, 97, 98, 112, 113, 122 and 126 under 35 U.S.C. §103 (a).

Claims 21, 22, 32, 33, 36, 99, 100, 114, 115 and 123 have been canceled. The rejection of these claims is now moot.

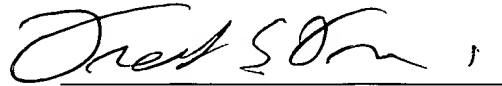
Conclusion

In view of the above remarks, Applicants respectfully request reconsideration and allowance of all the pending claims. The Commissioner is hereby authorized to charge or credit any deficiencies in connection with this response to deposit account No. 04-1425.

Respectfully Submitted,

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